

REMARKS

Claims 1-5, 8, 9 and 11-17 are pending in this application.

No claim has been amended by this Amendment After Final.

I. Prematureness of the Final Rejection

The Examiner made the Office action of December 3, 2002 (Paper No. 17) final.

The Examiner's assertion is improper because the Examiner introduces a new ground rejection that is not necessitated by the applicant's amendment of the claims.

Note that MPEP 706.07(a) recites *inter alia*,

Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p). Where information is submitted in an information disclosure statement during the period set forth in 37 CFR 1.97(c) with a fee, the examiner may use the information submitted, e.g., a printed publication or evidence of public use, and make the next Office action final whether or not the claims have been amended, provided that no other new ground of rejection which was not necessitated by amendment to the claims is introduced by the examiner. See MPEP ' 609.04(b) Furthermore, a second or any subsequent action on the merits in any application or patent undergoing reexamination proceedings will not be made final if it includes a rejection, on newly cited art, other than information submitted in an information disclosure statement filed under 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17 (p), of any claim not amended by

applicant or patent owner in spite of the fact that other claims may have been amended to require newly cited art....

A second or any subsequent action on the merits in any application or patent involved in reexamination proceedings should not be made final if it includes a rejection, on prior art not of record, of any claim amended to include limitations which should reasonably have been expected to be claimed. See MPEP ' 904 *et seq.* For example, one would reasonably expect that a rejection under 35 U.S.C. 112 for the reason of incompleteness would be replied to by an amendment supplying the omitted element.

Here, first, in the previous office action dated 24 March 2005 (Paper No. 03182005), the Examiner rejected claims 3, 7, 8, 10, 11 under 35 U.S.C. § 103 as being unpatentable over Ryman in view of Jones et al. and Kojima et al. or Monnett. Regarding the feature of claim 7 and claim 10, the examiner asserted that Jones et al. (col. 3, lines 41-45) disclose any coupling combinations which provide capacitance effect. The features of claims 7 and 10 were incorporated into claims 1 and 4, respectively, in the Amendment filed on 8 September 2005. In the subsequent final office action dated November 22, 2005 (Paper No. 11122005), the Examiner rejected claims 1 and 4 as amended under 35 U.S.C. §103(a) as being unpatentable over Ryman in view of European Patent Application (EP0746051) and Kojima et al. or Monnett. Regarding the features of the original claims 7 and 10 which were incorporated into claims 1 and 4, respectively, the examiner argued that European Patent Application (EP 0746051) discloses (Figs. 2, 3, 5)... the conductor shaft (PF) being inserted in the reception tube (CC) so that the first conductor and the second conductor are assembled with each other.

Therefore, the rejection is not necessitated by the applicant's amendment of the claims.

Please note that D'Oro et al. (U.S. Patent No. 5,856,767), which was considered by the examiner (see US PTO-892 form (Notice of Reference Cited)) is a patent family member of the European Patent Application (EP 0746051) (See Annex to the European Search Report on European Patent Application No. EP0376674.)

The newly cited reference (EP 0746051) is not a new reference for the examination purpose because D'Oro et al. (U.S. Patent No. 5,856,767) was already considered by the examiner.

Therefore, the finality of the action should be withdrawn.

II. Claim Rejections - 35 U.S.C. §103

Claims 1, 2, 4, 5, 8, 9, and 11-17 stand rejected under 35 U.S.C. §103 as being unpatentable over Ryman (U.S. Pat. No. 6,721,156) in view of European Patent Application (EP 0 746 051) and Kojima et al. or Monnett.

Claim 3 stands rejected under 35 U.S.C. §103 as being unpatentable over Ryman (U.S. Pat. No. 6,721,156) in view of Jones et al. (U.S. Pat. No. 6,061,223) and further in view of Kojima et al. or Monnett.

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally,

the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP section 2143 - Section 2143.03 for decisions pertinent to each of these criteria.

First, the examiner failed to establish a prima facie case of obviousness because the examiner failed to show that there is some suggestion or motivation to modify the reference.

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). (MPEP 2143.01)

Here, the examiner merely argued that, since Ryman '155 discloses the capacitor structure claimed but applied to the component 14 (col. 6, lines 51-54) and D'Oro '051 disclose in Figs. 2, 3 and 5 the conductor shaft (PF) being inserted in the reception tube (CC) so that the first conductor and the second conductor are assembled with each other. The examiner further argued that this combination is desirable to simplify the capacitive mechanism.

However, please note that the inner conductor 20 of Ryman '155 does not have to have the capacitance structure. That is, there is neither suggestion nor teaching that it is desirable to modify the inner conductor 20 of Ryman '155 to the capacitance mechanism structure.

The claimed inventions have the capacitor structure. The instant specification explains that "the DC power is not outputted to the second conductor 402, because the first conductor 400

and the second conductor 402 assembled with each other construct a capacitor” (the English translation page 10, lines 16-17).

With this function, the Ryman ‘155 expressly discloses this function at col. 10, lines 16 to 26 as follows:

“A DC blocking device 80 is operatively coupled in series with the first inner conductor 20 of the through-section 12. The DC blocking device 80 blocks DC current from propagating toward the first end 15 of the through-section 12, which is the source of the RF signals, but permits the DC current to propagate in the direction toward the second end 16 of the through-section, where the active components may be located. **The DC blocking device 80 is preferably a commercially available capacitor, which is coupled in series with the inner conductor 20** of the through-section 12” (emphasis added).

The arrangement of the DC blocking device 80 is also shown in Fig. 3 of Ryman ‘155. According to Ryman ‘155’s teaching, the DC blocking device is additionally coupled in series with the first inner conductor.

At most, the examiner may argue that the DC blocking device of Ryman ‘155 rather than the inner conductor 20 of Ryman ‘155 may be replaced with the structure of D’Oro ‘051. This is an element separately coupled in series with the inner conductor 20 of Ryman ‘155. Even if this blocking device is replaced with the structure of D’Oro et al. ‘767, the suggested capacitor is still an element separately coupled in series with the inner conductor 20 of Ryman ‘155. On the other hand, the present invention, the structure of the center conductor makes an additional separate capacitor unnecessary because the center conductor has a structure to function as electrode plates of a capacitor.

Even if the two references are combined, the claimed invention is not taught or suggested.

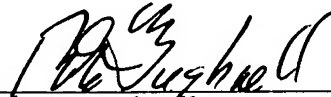
Second, the examiner merely argued that the examiner's combination would simplify the blocking capacitive mechanism. To reach a proper determination under 35 U.S.C. §103, [k]nowledge of applicant's disclosure must be put aside in reaching this determination, yet kept in mind in order to determine the "differences," conduct the search and evaluate the "subject matter as a whole" of the invention. The tendency to resort to "hindsight" based upon applicant's disclosure is often difficult to avoid due to the very nature of the examination process. However, impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art. It should be noted that the simplification of the manufacturing process is one of the objectives of the instant application and the prior art references does not recognize the problems, as stated above, which are solved by the present application, and does not provide a solution to achieve the above objectives.

For at least one of the above reasons, the examiner's reasoning is not proper. Withdrawal of the rejections is respectfully requested.

In view of the above, all claims are submitted to be allowable and this application is believed to be in condition to be passed to issue. Reconsideration of the rejections is requested. Should any questions remain unresolved, the Examiner is requested to telephone Applicant's attorney.

No fees are incurred by this Amendment. Should the other fees be incurred, the Commissioner is authorized to charge Deposit Account No. 02-4943 of Applicant's undersigned attorney in the amount of such fees.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'R. E. Bushnell', written over a horizontal line.

Robert E. Bushnell,
Attorney for the Applicant
Registration No. 27,774

1522 "K" Street, N.W., Suite 300
Washington, D.C. 20005
(202) 408-9040

Folio: P56939
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I.D.: REB/JHP